

## REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of January 10, 2008 and respectfully requests reconsideration of the application.

Claims 1-181 are now pending, a total of 181 claims. Claims 1, 2, 28, 31, 53, 56, 60, 74, 93, 102, 119, 130, 133, 140, 148, 154, 158, 161, 172, 179, 180 and 181 are independent.

### **I. No Restriction is Appropriate Because There Cannot Be Any Serious Search Burden**

Any restriction requirement requires a showing of “serious search burden.” MPEP §§ 803, 803.02, 806.04(a)-(j), 808.01(a) and 808.02 Such a showing cannot be made in this case for the following reasons:

- No further search is required. At least claims 1-118 have been searched by three previous examiners (Examiners Soh, Kanoff, and Chencinski), and have been found to be allowable over all art located by those three examiners. (See Action of November 1, 2006, indicting that all claims are allowed over the art). Examiner Subramanian is required to give “full faith and credit” to this determination, and is not permitted to open a new search. MPEP §§ 704.01, 706.04. If no search is permitted, there cannot be a “serious” search burden, and thus no restriction can be supported.
- Every previous Action that applied art against the claims applied a single primary reference to all rejected claims. This strongly suggests that the claims cannot be so divergent from each other that they require multiple burdensome searches.

If no “serious search burden” can be shown, no restriction is appropriate.

MPEP § 704.01 states (underline added):

“When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something.”

In the telephonic interview with Examiner Subramanian on May 30, 2008, the Examiner stated that he had no knowledge of any new prior art, and did not identify any “clear error in the previous action” of allowing claims 1-118 over the art. (See paragraph 7 of interview summary). Thus, the Examiner is required to give full faith and credit to prior searches, and is not permitted

to reopen prosecution except on art of which he has personal knowledge. Having conceded that there is no such art, no further search is required or permitted.

The Action fails to comply with PTO requirements to give “full faith and credit,” and therefore raises no legally-cognizable requirement. *Service v. Dulles*, 354 U.S. 363, 388-89 (1957) (when an agency violates its own agency procedural manual, the agency action is void, and has no effect and imposes no requirement). No election is required. The Examiner’s assertions in the May 30, 2008 telephonic interview that he must keep searching the case over and over again each time he handles the case, is clearly contradicted by mandatory instructions of the Director.

## II. The Groups are Misclassified

The title of this application, and the subject matter of all claims, suggests that all claims are most appropriately classified for search in 705/35:

**35 Finance (e.g., banking, investment or credit):** This subclass is indented under subclass 1. Subject matter drawn to a computerized arrangement for planning the disposition or use of funds or securities, or extension of credit.

The Action proposes to search claims 1-27, 31-52, 56-59 and 74-181 in subclass 705/36T. 705/36T is not available in the web page of “Class Definitions” for class 705 (<http://www.uspto.gov/go/classification/uspc705/defs705.htm>), however, it is Applicant’s understanding that 705/36T is directed to tax-reduction methods. However, almost none of the independent claims in Group I recite anything to do with taxes. *E.g.*, claims 2, 56, 74, 93, 102, 119, 130, 133, 148, 154, 158, 161, 172, 179. Financial accounting and tax accounting are not the same thing. The Examiner’s explanation given in the interview reflects an incorrect understanding of the relationship between the disciplines. Classification in 705/36T is simply wrong.

Likewise, the Action proposes to search claims 28-30 and 53-55 in 705/26. This is likewise an incorrect search classification, which will result in an inefficient search. The definition for 705/26 is as follows:

**26 Electronic shopping (e.g., remote ordering):** This subclass is indented under subclass 1. Subject matter drawn to a computerized arrangement which enables a purchaser to inspect or select from a plurality of different items, or effect a purchase of one or more items at a location geographically separated from the system user.

(1) Note. A remote shopping system is included in this subclass.

705/26 is not a well-chosen class for search. These claims recite no specialized “computer arrangement” for shopping. The features of these claims on which search should focus are the interlocking financing structures, not the “shopping” apparatus.

The Action proposes to search claims 60-73 in 705/36T. The independent claim of this group, claim 60, is silent on “tax” issues. The classification is clearly incorrect.

Because the Office Action is so clearly faulty, no informed election can be made.

### **III. Restriction Among Groups I and III is Improper On Its Face**

MPEP § 808.02 reads as follows:

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.

The Office Action concedes that Groups I and III are “related” (page 4, middle of the page). The Action also proposes to classify Groups I and III to the same search class. Restriction between these two Groups violates MPEP § 808.02, and Applicant assumes that this restriction is withdrawn.

### **IV. Directive on 101 Panel**

During the telephonic interview of May 30, 2008 as well as earlier telephonic interviews, Examiner Subramanian referred to a 101 panel and a Directive from Director Coggins that all examiners must consult a 101 panel on claims before allowing the claims and that the examiners must follow the decision of the panel. The undersigned requested a copy of the Directive from Examiner Kalinowski, but he said he did not know what Directive Examiner Subramanian was referring to. He suggested that Examiner Subramanian was referring to a memo by Love published on the PTO website. Attached is a copy of the Love memo. It is requested that Examiner Subramanian advise the Applicant if the Love memo was what he was referring to. It is unlikely that the Love memo is what Examiner Subramanian was referring to since the Love memo does not mention panels at all, is from Love and not Director Coggins, and is dated May 15, 2008, well after Examiner Subramanian first mentioned the panels to me. If the Love memo is not what Examiner Subramanian was referring to in his discussions with me, I request that he

provide the Applicant with a copy of the Directive from Director Coggins that he was referring to.

## VI. Conclusion

Applicant elects Groups I and III, claims 1-27, 31-52, 56-73 and 74-181, with traverse. Applicant also notes that any proposal to restrict claims 28-30 and 53-55 is too poorly supported in the January 2008 paper to mature into a final withdrawal of claims. If the improper restriction requirement between Groups I and III is maintained, Applicant alternatively elects Group I claims with traverse.


Should the requirement for restriction be made final, the Examiner is respectfully requested to state on the record that the claims in each group are patentable (novel and nonobvious) over each other.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance.

Included herein is Petition for Extension of Time for four months. In the event that a further extension of time is required, Applicant petitions for that extension of time required to make this reply timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3219, Order No. 1906-003 .

Respectfully submitted,

Dated: June 10, 2008

By:   
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/Donna L. Angotti/  
Registration No. 32,679

LAW OFFICES OF DONNA ANGOTTI  
140 Broadway, Suite 4600  
New York, NY 10005  
(212) 858-7515  
(212) 858-7750 (FAX)